

REMARKS

Claims 1 and 9 have been amended. Claims 1-16 remain in the application. Reconsideration of the application in view of the amendments and the remarks to follow is requested.

Claims 1-16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Tsikos (4,507,557). Claims 1-16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tsikos.

Independent claim 1 is amended to recite a position pointing device **having a light emitting means** and said position pointing device being detected by obtaining an incident angle of light emitted from said position pointing device to each optical unit. Tsikos fails to teach or suggest a position pointing device having a light emitting means. Tsikos teaches light “originates from point sources (e.g., L.E.D’s.) at the lower left and the lower right corner of the viewing field” (col. 5, lines 5-10; Fig. 1). That is, L.E.D.’s at the corners of a frame 12 send out light to locate object 26 (position device) positioned within the borders of the frame 12 by creating shadows on retro-reflective surface 14 (col. 5, Figs. 1-2). Accordingly, in no fair or reasonable interpretation does Tsikos teach or suggest, singularly or in any combination, a position pointing device **having a light emitting means** as positively recited in claim 1. Since Tsikos fails to teach or suggest, singularly or in any combination, positively recited limitations of claim 1, the anticipation and obviousness rejections must fail. Claim 1 is allowable.

Additionally, the Examiner has failed to provide any motivational rationale for modifying the Tsikos invention as required for a proper obviousness rejection, the therefore, the obviousness rejection must fail. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143.01 (8th edition) *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). “Preferably the Examiner’s explanation should be such that it provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification.” *Ex Parte Levengood*, 28 USPQ2d, 1300, 1301, Footnote 2, (Bd. Pat. App. and Inter. 1993) (citations omitted). The Examiner has not provided that impetus necessary to cause one skilled in the art to make the proposed modification of Tsikos, other than to state one could do so, and therefore, pursuant to the above authority, the obviousness rejection must fail.

Moreover, the Examiner is respectfully reminded that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01 (8th edition) *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so”. 916 F.2d at 682, 16

USPQ2d at 1432; MPEP §2143.01; See also *In re Finch*, 972 F.2d, 1260, 23 USPQ2d, 1780 (Fed. Cir. 1992). By not providing any motivational rationale for modifying Tsikos, the Examiner is simply stating that the Tsikos reference can be modified without providing the desirability of the modification, pursuant to the above authority. For this additional reason, the obviousness rejection is inappropriate and should be withdrawn.

Claims 3-8 depend from independent claim 1, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

Independent claim 9 is amended to recite a position pointing device having a light emitting means and said position pointing device being detected by obtaining an incident angle of light emitted from said position pointing device to each optical unit. These are the same limitations discussed above with respect to claim 1, and therefore, claim 9 is allowable for all the reasons presented previously with respect to claim 1. Claim 9 is allowable.

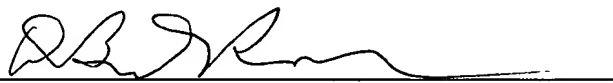
Claims 10-16 depend from independent claim 9, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next

anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

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